



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,100	04/24/2002	Miwako Yuasa	450119-03130	7271
20999 7590 11/14/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER				
GRAHAM, CLEMENT B				
ART UNIT		PAPER NUMBER		
3696				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/018,100

**Applicant(s)**

YUASA ET AL.

**Examiner**

Clement B. Graham

**Art Unit**

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/309)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-38 remained pending in this Application.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/22/08 has been entered.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-38, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe et al, (Hereinafter Hasebe U.S Patent: 6, 829, 592) in view of Tagawa et al, (Hereinafter Tagawa U.S Patent: 7, 315, 829).

As per claims 1-3, Hasebe discloses a system for managing lease of arbitrary information contents to be distributed from an information lease service provider to a user, the system comprising:

an information lease management apparatus for adding utilization condition ("i. e, charge") information concerning lease of copyrighted information contents to copyrighted information contents, and processing the information so as to be distributed to the user. (see column 1 lines 29-38 and column 4 lines 37-54) an information processing apparatus for receiving information copyrighted contents with utilization condition information distributed from the information

Art Unit: 3696

lease management apparatus and communication means for connecting the information lease management apparatus and information processing apparatus (see column 1 lines 29-38 and column 4 lines 37-54).

Hasebe fail to explicitly teach wherein the information processing apparatus deletes the received copyrighted information contents in accordance with the utilization condition information.

However Twagawa discloses the second authentication unit has a control function and mediates between the secondary recording medium and the first authentication unit, performing a command/response operation therewith. The secondary recording medium is composed of a flash memory such as EEPROM (Electrically Erasable Programmable Read-Only Memory).(see column 6 lines 4-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hasebe to include wherein the information processing apparatus deletes the received copyrighted information contents in accordance with the utilization condition information taught by Twagawa in order to prevent data usage of which is forbidden with out permission.

Further copyrighted information represent non functional descriptive material because the data is not functional.

As per claim 4, Hasebe discloses wherein a contract concerning lease of said copyrighted information contents is made between said information lease service provider and a user (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 5, Hasebe discloses characterized in that Internet, telephone lines, satellite communication line or lease communication lines are used as said communication means. (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 6, Hasebe discloses a copyright management apparatus for managing lease of copyrighted information contents distributed from copyrighted information lease service provider to a user, the apparatus comprising:  
data processing means for adding utilization condition (“i. e, charging”) information concerning lease information of copyrighted information contents to a user (see column 1 lines 29-38 and column 4 lines 37-54) and transmission and reception means for distributing to a user the

Art Unit: 3696

information contents having the utilization condition ("i. e, charge") information added thereto by the data processing means or receiving response information from the user (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 7, Hasebe discloses further comprising a database storing the copyrighted information contents to be leased to said user (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 8, Hasebe discloses wherein at least menu screen information describing a title of copyrighted information contents stored in said database is provided to user (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 9, Hasebe discloses wherein at least a title of said copyrighted information contents, lease charge and lease period, and a list of said users are integrally managed (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 10, Hasebe discloses wherein when an upper limit of an amount of money predetermined in accordance with a contract is provided, said data processing means obtains a cumulative utilization charge in which lease charges of said copyrighted information contents are cumulated (see column 1 lines 29-38 and column 4 lines 37-54).

Hasebe fail to explicitly teach compares said upper limit of an amount of money and said cumulative utilization charge with each other; and present lease rejection of said copyrighted information contents or a change of said upper limit of an amount of money when said cumulative utilization charge exceeds said upper limit of amount of money.

However Twagawa discloses the second authentication unit has a control function and mediates between the secondary recording medium and the first authentication unit, performing a command/response operation therewith. The secondary recording medium is composed of a flash memory such as EEPROM (Electrically Erasable Programmable Read-Only Memory) (see column 6 lines 4-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hasebe to include compares said upper limit of an amount of money and said cumulative utilization charge with each other; and present lease rejection of said copyrighted information contents or a change of said upper limit of an amount of money

Art Unit: 3696

when said cumulative utilization charge exceeds said upper limit of amount of money taught by Twagawa in order to prevent data usage of which is forbidden with out permission. Further copyrighted information represent non functional descriptive material because the data is not functional.

As per claims 11-12, 19, 21-22, Hasebe discloses an apparatus for receiving information contents leased from a copyrighted information lease service provider to a user, said apparatus characterized by comprising:

transmission and reception means for receiving copyrighted information contents having added thereto utilization condition information concerning lease information to the user; data processing means for processing information contents received by the transmission and reception means (see column 1 lines 29-38 and column 4 lines 37-54) and a recording medium connectable to the data processing means in order to store information contents (see column 1 lines 29-38 and column 4 lines 37-54).

Hasebe fail to explicitly teach wherein the data processing means is provided so as to delete the copyrighted information contents in a recording medium in accordance with the utilization condition information.

However Twagawa discloses the second authentication unit 127 has a control function and mediates between the secondary recording medium 128 and the first authentication unit, performing a command/response operation therewith. The secondary recording medium is composed of a flash memory such as EEPROM (Electrically Erasable Programmable Read-Only Memory).(see column 6 lines 4-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hasebe to include wherein the data processing means is provided so as to delete the copyrighted information contents in a recording medium in accordance with the utilization condition information taught by Twagawa in order to prevent data usage of which is forbidden with out permission.

Further copyrighted information represent non functional descriptive material because the data is not functional.

As per claim 13, Hasebe discloses characterized in that said data erasure mechanism comprises:

detection means for detecting the fact that the recording medium is removed from said data processing means, and control means for controlling disconnection of power supply to storage means based on removal detection information caused by said detection means. (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 14, Hasebe characterized in that, when power supply to said recording medium is disconnected, there is provided a lock mechanism for fixing the recording means to said data processing means (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 15, Hasebe discloses further comprising display means for displaying index information concerning said copyrighted information contents (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 16, Hasebe discloses wherein at least a menu screen describing a title of said copyrighted information contents is displayed on said display means (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 17, Hasebe discloses wherein arbitrary copyrighted information contents selected from said menu screen are distributed to said recording medium (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 18, Hasebe discloses further comprising operation means operated so as to input setting information concerning lease of said copyrighted information contents (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 20, Hasebe wherein said utilization condition information contains a control program for selecting whether or not a lease period of said copyrighted information contents is extended (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 23, Hasebe discloses a method of managing lease of copyrighted information contents distributed from information lease service provider to a user by using communication means, said method comprising the steps of:  
making a contract concerning lease of copyright information contents in advance between the information lease service provider and the user (see column 1 lines 29-38 and column 4 lines 37-54) adding utilization condition("i. e, charge") information to copyrighted information contents to be distributed to the user based on the contract and receiving copyright information contents having utilization condition information added thereto on the other hand (see column 1

lines 29-38 and column 4 lines 37-54) and storing the received copyrighted information contents in a recording medium (see column 1 lines 29-38 and column 4 lines 37-54).

Hasebe fail to explicitly teach automatically erasable time limit storage function; and deleting the copyrighted information contents stored in the recording medium in accordance with the utilization condition information.

However Twagawa discloses the second authentication unit has a control function and mediates between the secondary recording medium and the first authentication unit, performing a command/response operation therewith. The secondary recording medium is composed of a flash memory such as EEPROM (Electrically Erasable Programmable Read-Only Memory) (see column 6 lines 4-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hasebe to include automatically erasable time limit storage function; and deleting the copyrighted information contents stored in the recording medium in accordance with the utilization condition information taught by Twagawa in order to prevent data usage of which is forbidden with out permission.  
Further copyrighted information represent non functional descriptive material because the data is not functional.

As per claim 24, Hasebe discloses an information lease management method as claimed in claim 23, characterized in that Internet or communication lines such as telephone line or satellite communication lines are used (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 25, Hasebe discloses wherein, when said recording medium is attached to a data processing unit, and said storage medium is removed from said data processing unit, the copyrighted information contents contained in said recording medium (see column 1 lines 29-38 and column 4 lines 37-54).

Hasebe fail to explicitly teach deleted.

However Twagawa discloses the second authentication unit 127 has a control function and mediates between the secondary recording medium 128 and the first authentication unit, performing a command/response operation therewith. The secondary recording medium is composed of a flash memory such as EEPROM (Electrically Erasable Programmable Read-Only Memory).(see column 6 lines 4-10).



Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hasebe to include deleted taught by Twagawa in order to prevent data usage of which is forbidden with out permission

Further copyrighted information represent non functional descriptive material because the data is not functional.

As per claim 26, Hasebe discloses further comprising the step of presenting a user with index information concerning a plurality of copyrighted information contents to be leased to said user. (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 27, Hasebe discloses an information lease management method as claimed in claim 26, further comprising the step of displaying at least a menu screen describing a title of said copyrighted information contents (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 28, Hasebe discloses further comprising the step of distributing arbitrary copyrighted information contents selected from said menu screen (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 29, Hasebe discloses further comprising the step of arbitrarily inputting a lease period of said copyrighted information contents with respect to a lease contract of said copyrighted information contents (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 30, Hasebe discloses further comprising the step of setting an upper limit of an amount of money for utilization charge of said copyrighted information contents with respect to a lease contract of said copyrighted information contents (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 31, Hasebe discloses further comprising the steps of:  
when an upper limit of an amount of money is set with respect to a lease of said copyrighted information contents, obtaining a cumulative utilization charge in which at least lease charges of said copyrighted information contents are cumulated (see column 1 lines 29-38 and column 4 lines 37-54).

Hasebe fail to explicitly teach comparing said upper limit of an amount of money with said cumulative utilization charge and when said cumulative utilization charge exceeds said upper limit of an amount of money, presenting lease rejection of said copyrighted information contents or a change of said upper limit of an amount of money.

However Twagawa discloses the second authentication unit has a control function and mediates between the secondary recording medium and the first authentication unit, performing a command/response operation therewith. The secondary recording medium is composed of a flash memory such as EEPROM (Electrically Erasable Programmable Read-Only Memory).(see column 6 lines 4-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hasebe to include comparing said upper limit of an amount of money with said cumulative utilization charge; and when said cumulative utilization charge exceeds said upper limit of an amount of money, presenting lease rejection of said copyrighted information contents or a change of said upper limit of an amount of money taught by Twagawa in order to prevent data usage of which is forbidden with out permission. Further copyrighted information represent non functional descriptive material because the data is not functional.

As per claim 32, Hasebe discloses an information lease management method as claimed in claim wherein, when age limitation is set with respect to lease of said copyrighted information contents, a predetermined user registered password number is input (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 33, Hasebe discloses selecting whether or not the lease period of said copyrighted information contents is extended when a lease period of said copyrighted information contents has expired (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 34, Hasebe discloses an information lease management method as, further comprising the step of integrally managing at least a title of said copyright tin formation contents, lease charge and lease period, and a list of said users (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 35-36, Hasebe discloses computer readable medium storing a computer program for recording copyrighted information contents embedded with utilization condition information leased from a copyright information lease service provider to a user a computer, comprising the steps of: (see column 1 lines 29-38 and column 4 lines 37-54).

Hasebe fail to explicitly teach deleting when a predetermined lease period has expired, copyrighted information contents stored in the recording medium in accordance with utilization condition information.

However Twagawa discloses the second authentication unit 127 has a control function and mediates between the secondary recording medium 128 and the first authentication unit, performing a command/response operation therewith. The secondary recording medium is composed of a flash memory such as EEPROM (Electrically Erasable Programmable Read-Only Memory).(see column 6 lines 4-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hasebe to include when a predetermined lease period has expired, copyrighted information contents stored in the recording medium in accordance with utilization condition information taught by Twagawa in order to prevent data usage of which is forbidden with out permission. Further copyrighted information represent non functional descriptive material because the data is not functional.

As per claim 37, Hasebe discloses wherein said data erasure mechanism comprises: detection means for detecting the fact that the recording medium is removed from said data processing means; and control means for controlling disconnection of power supply to storage means based on removal detection information caused by said detection means. (see column 1 lines 29-38 and column 4 lines 37-54).

As per claim 38, Hasebe discloses wherein power supply to the recording medium is disconnected, there is provided a lock mechanism for fixing the recording medium to said data processing means (see column 1 lines 29-38 and column 4 lines 37-54).

### **Conclusion**

### **RESPONSE TO ARGUMENTS**

5.. Applicant's arguments filed 8/22/08 has been fully considered but they are not persuasive for the following reasons.

6. In response to Applicant's arguments that Hasebe and Twagawa fail to teach or suggest "an information lease management apparatus for adding utilization condition information concerning lease of copyrighted information contents to copyrighted information contents, and

processing the information so as to be distributed to the user an information processing apparatus for receiving information copyrighted contents with utilization condition information distributed from the information lease management apparatus and communication means for connecting the information lease management apparatus and information processing apparatus wherein the information processing apparatus deletes the received copyrighted information contents in accordance with the utilization condition information” the examiner disagrees with Applicant’s because these claimed limitations were addressed as stated.

Hasebe an information lease management apparatus for adding utilization condition (“i. e, charge”) information concerning lease of copyrighted information contents to copyrighted information contents, and processing the information so as to be distributed to the user. (see column 1 lines 29-38 and column 4 lines 37-54) an information processing apparatus for receiving information copyrighted contents with utilization condition information distributed from the information lease management apparatus and communication means for connecting the information lease management apparatus and information processing apparatus (see column 1 lines 29-38 and column 4 lines 37-54).

Twagawa discloses the second authentication unit has a control function and mediates between the secondary recording medium and the first authentication unit, performing a command/response operation therewith. The secondary recording medium is composed of a flash memory such as EEPROM (Electrically Erasable Programmable Read-Only Memory) (see column 6 lines 4-10).

Therefore it is obviously clear that Applicant’s claimed limitations were addressed within the teachings of Hasebe and Twagawa.

Further copyrighted information represent non functional descriptive material because the data is not functional.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

Art Unit: 3696

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frantzy Poinvil/  
Primary Examiner, Art Unit 3696

CG

Non 5, 2008